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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/615,883	07/09/2003	Philip Davis	1019-2	9836
7590	11/21/2006		EXAMINER	
Mark Sgantzos THE MARTINEZ GROUP PLLC 55 Poplar Street, Suite 1-D Brooklyn Heights, NY 11201			HOGE, GARY CHAPMAN	
			ART UNIT	PAPER NUMBER
			3611	

DATE MAILED: 11/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/615,883	DAVIS, PHILIP
	Examiner	Art Unit
	Gary C. Hoge	3611

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 01 November 1999.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) 3-8, 14, 17-22 and 28 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1,2,9-13,15,16 and 23-27 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)
 Paper No(s)/Mail Date _____
- 4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date. _____
- 5) Notice of Informal Patent Application
- 6) Other: _____

DETAILED ACTION

Election/Restrictions

1. Claims 3-8, 14, 17-21, 22 and 28 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on April 10, 2006.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 15 and 23-27 are rejected under 35 U.S.C. 102(b) as being anticipated by Lane (279,490).

Lane discloses a matting system having a carrier mat (c) with at least one window and a display mat (d) having at least one window smaller than the window in the carrier mat, the display mat being adhered to the carrier mat so that the window of the display mat is in-line with the window in the carrier mat; and a frame extension, being established around the window of the carrier mat by the smaller window of the display mat relative to the carrier mat (see Fig. 6); a display item positioned in the window of the carrier mat (page 1, lines 87-97); and a backer mat (e) positioned behind the carrier mat.

Regarding claim 23-27, it has been held that apparatus limitations are not entitled to patentable weight in a method claim. *Ex parte Akamatsu*, 22 USPQ2d 1915.

4. Claims 1, 15 and 23-27 are rejected under 35 U.S.C. 102(b) as being anticipated by Cohart (5,279,880).

See Fig. 6. Cohart discloses a matting system having a carrier mat **16** with at least one window **20** and a display mat **10** having at least one window **12** smaller than the window in the carrier mat, the display mat being adhered to the carrier mat (col. 5, lines 11-14) so that the window of the display mat is in-line with the window in the carrier mat; and a frame extension, being established around the window of the carrier mat by the smaller window of the display mat relative to the carrier mat (see Fig. 6); a display item positioned in the window of the carrier mat (page 1, lines 87-97); and a backer mat **24** positioned behind the carrier mat.

Regarding claim 23-27, it has been held that apparatus limitations are not entitled to patentable weight in a method claim. *Ex parte Akamatsu*, 22 USPQ2d 1915.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 2, 9-13, 16 and 23-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cohart (5,279,880) in view of Lane (279,490).

Cohart discloses the invention substantially as claimed, as set forth above. However, the flap **22** is not hinged to the carrier mat **16**. Lane teaches that it was known in the art to hinge such

a flap. It would have been obvious to one having ordinary skill in the art at the time the invention was made to hinge the flap disclosed by Cohart, as taught by Lane, in order that the flap might not get lost.

Regarding claims 9 and 23, the hinge disclosed by Lane is gummed tape. The adjective "archival" is a statement of intended use and does not define over the prior art.

Regarding claims 10-13 and 24-27, Lane does not disclose what type of adhesive and what type of tape is contemplated. Because it is within the level of ordinary skill of a worker in the art to select from among known materials on the basis of their suitability for the fabrication of a given device, and since a person having ordinary skill in the art would know that any known tape and any known adhesive, and specifically pressure sensitive linen tape, non-porous film with archival grade adhesive, non-woven polyethylene and acrylic adhesive, and acid-free paper adhered with wheat starch, rice starch or a synthetic methyl-cellulose type paste, would be suitable for the fabrication of a hinge of the type disclosed by Lane, it would have been obvious to one having ordinary skill in the art at the time the invention was made to fabricate the hinge disclosed by Lane from pressure sensitive linen tape, non-porous film with archival grade adhesive, non-woven polyethylene and acrylic adhesive, and acid-free paper adhered with wheat starch, rice starch or a synthetic methyl-cellulose type paste as a matter of choice in design, based on such factors as cost and availability of the materials to the designer.

Response to Arguments

7. Applicant's arguments filed November 11, 2006 have been fully considered but they are not persuasive.

Regarding Lane, Applicant states that “there is no showing in Lane of a specifically claimed non-adhesive matting system having a plurality of mats. Lane shows a photo wherein the photo is affixed to the card by a gummed tape (Figure 12).” Unfortunately, Applicant has misunderstood the Lane disclosure. What Applicant characterizes as a “photo” affixed to a card by gummed tape is in fact a “thin piece of transparent gelatine tissue” (page 1, line 58), which, together with the plurality of mats disclosed by Lane forms “a receptacle or pocket” (page 1, line 70). Into this pocket is placed a “souvenir or memento,” for example, “a lock of hair, a dried flower, an autograph, a manuscript poem, an original sketch, a photograph, or a fragment of rock from some interesting locality” (page 1, lines 87-91). Applicant further states that “the item to be displayed in the instant invention, as claimed, is positioned in the frame extension created by the carrier and display mats and subsequently; the backer mat is positioned behind the carrier mat.” As explained above, Lane discloses all of this structure. In Lane, a carrier mat (c) with a window and a display mat (d) having a window smaller than the window in the carrier mat, thereby forming a frame extension, form a pocket into which a display item is positioned. A backer mat (e) is positioned behind the carrier mat.

Regarding the method claims, Applicant states that “Lane is completely silent with respect to having a specific method of displaying items in a matted frame. The claims are specific in the method in which the mats are assembled and in the manner in which the display item is inserted into the mats.” But, the method of claim 15 includes the following steps:

“Providing a carrier mat . . .” Lane provides a carrier mat.

“Adhering the display mat to the carrier mat . . .” Lane discloses a display mat that is adhered to the carrier mat.

“inserting a display item in the window of the carrier mat.” Lane discloses inserting a display item in the window of the carrier mat.

“providing a backer mat positioned behind the carrier mat.” Lane provides a backer mat that is positioned behind the carrier mat.

Regarding Cohart, Applicant has also misunderstood the disclosure of this reference. For example, Applicant states that “Cohart shows a photo 26 in both Figures 5 and 6, which is placed on a back mat 24 and subsequently, the mats 10 and 16 are placed over the photo.” But Cohart states that “well mat 16 is first secured to the back of front mat 10 using an appropriate adhesive, thus forming a well having an opening 20. Front mat 10, with well mat 16 secured thereto, is then laid face down on a flat surface. Opening 20 is approximately the same size as the dimensions of picture 26 so that picture 26 may then be placed within opening 20” (column 5, lines 11-18). Thus, it is clear that the photo disclosed by Cohart is “approximately the same size as” the opening 20 in the middle mat 16, not “larger than that of the opening of the middle mat,” as stated by Applicant. The Examiner has pointed out above how Cohart discloses each of the claimed limitations, and Applicant has not pointed out a single claimed limitation that Cohart does not disclose.

Applicant’s misunderstanding of both Lane and Cohart leads to the erroneous conclusion that “the teaching of a hinged flap as taught by Lane incorporated into the Cohart back mat would not have been obvious . . . since both Lane and Cohart teach that their respective items to be displayed are structurally supported by tape (m) as shown in Lane and by mats 16 and 24 in Cohart.” On the contrary, the item to be displayed by Lane is supported between the frame created by the display mat (d) and the hinged flap (i). The item to be supported by Cohart is

supported between the frame created by front mat 10 and the flap 22. The only difference is that the flap disclosed by Cohart is not hinged, and the flap disclosed by Lane is hinged.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

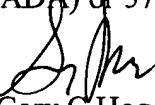
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gary C. Hoge whose telephone number is (571) 272-6645. The examiner can normally be reached on 5-4-9.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lesley Morris can be reached on (571) 272-6651. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3611

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Gary C Hoge
Primary Examiner
Art Unit 3611

gch